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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/769,743 | 01/23/2004 | Robert L. Diaz | 2385.005 | 6554 |
| 21917 | 7590 | 05/30/2006 | | EXAMINER |
| MCHALE & SLAVIN, P.A. 2855 PGA BLVD PALM BEACH GARDENS, FL 33410 | | | | HOFFMAN, MARY C |
| | | | ART UNIT | PAPER NUMBER |
| | | | | 3733 |

DATE MAILED: 05/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|------------------------------|------------------------|---------------------|
| | 10/769,743 | DIAZ, ROBERT L. |
| Examiner | Art Unit | |
| Mary Hoffman | 3733 | |

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 27 April 2006.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-23 is/are pending in the application.
4a) Of the above claim(s) 1-18 and 20-23 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 19 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 23 January 2004 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election of invention V, species D (i.e. claim 19) in the reply filed on 4/27/2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 1-18 and 20-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention/species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 4/27/2006.

Drawings

The drawings are objected to because the reference numbers are difficult to read/illegible, also see attached PTO-948. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the

several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Bryan et al. (U.S. PG Pub. 2002/0161446).

Bryan et al. discloses a surgical kit for disk arthroplasty comprising instruments and an artificial implant, the instruments being a sizing instrument (FIG. 4, ref. #18), a distractor (FIG. 19, ref. #140), and a cutting block (FIG. 32B, ref. #300) and an artificial implant (paragraph [0402]). In paragraph [0402], the Bryan et al. incorporates by reference the artificial implant described more fully in U.S. application 09/783910, (or see PG. Pub 2002/0035400). The artificial includes a superior body (ref. #20) for attachment to a superior vertebral surface and an inferior body (ref. #40) for attachment

to an inferior vertebral surface, the inferior body having a peripheral wall with a peripheral ring (ref. #86) formed thereon; the implant including a mobile bearing (ref. #60) capable of being placed between the inferior and superior bodies, wherein a surface of the mobile bearing is complementary to a surface of the superior body and a surface of the inferior body (see areas of contact between mobile bearing and inferior/superior bodies), the mobile bearing including a circumferential groove (ref. #62) to receive the ring to secure the bearing to the inferior

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 19 is rejected under 35 U.S.C. 102(e) as being anticipated by Bryan et al. (U.S. Patent Application 2003/0135277).

Bryan et al. disclose a surgical kit for disk arthroplasty comprising instruments and an artificial implant, the instruments being a sizing instrument (FIG. 19B, ref. #142), a distractor (FIG. 27, ref. #320), and a cutting block (FIG. 37, ref. #390) and an artificial implant including a superior body (ref. #20) for attachment to a superior vertebral surface and an inferior body (ref. #40) for attachment to an inferior vertebral surface, the inferior body having a peripheral wall with a peripheral ring (ref. #88) formed thereon, the implant including a mobile bearing (ref. #99) capable of being placed between the inferior and superior bodies, wherein a surface of the mobile bearing is complementary to a surface of the superior body and a surface of the inferior body (see areas of contact between mobile bearing and inferior/superior bodies), the mobile bearing including a

circumferential groove (ref. #62) to receive the ring to secure the bearing to the inferior body (page 2, paragraph [0014]).

Response to Arguments

Applicant's arguments filed 4/27/2006 with respect to claim 19 being reject under the Bryan et al. references ('446 and '277) have been fully considered but they are not persuasive.

Contrary to that which applicant has suggested, the Bryan et al. references ('446 and '277) cited above clearly anticipate an artificial implant including a superior body for attachment to a superior vertebral surface and an inferior body for attachment to an inferior vertebral surface, the inferior body having a peripheral wall with a peripheral ring formed thereon, the implant including a mobile bearing capable of being placed between the inferior and superior bodies, wherein a surface of the mobile bearing is complementary to a surface of the superior body and a surface of the inferior body, the mobile bearing including a circumferential groove to receive the ring to secure the bearing to the inferior body. With regard to functional statements (e.g. "constructed and arranged to receive said peripheral ring to secure said bearing to said inferior body"), they do not impose any structural limitations on the claims distinguishable over the Bryan et al. references ('446 and '277), which are capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only

necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Applicant's arguments with respect to claim 19 being rejected under the Ferree reference (2004/0073311) have been considered but are moot, as the rejection under Ferree of claim 19 has been withdrawn in light of applicant's amendment.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 9:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MCH



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER